

REMARKS

By this Amendment, Claims 1, 4, 7, 12, 13, 16 and 18 have been amended, Claims 2, 5, 6, 8, 11, 14, 15, 17 have been deleted, without prejudice, and new Claims 19-26 have been added, to place this application in immediate condition for allowance.

First, Applicant wishes to thank the Examiner for the indication of the allowability of Claims 9 and 18. In this regard, as will be explained in greater detail hereinafter, new Claims 19-26 consist of independent Claim 19 and dependent Claims 20-26. New independent Claim 19 consists of the combination of originally presented Claims 1 and 9 with minor additional amendments merely for matters of form.

In the outstanding Office Action, the Examiner rejected Claims 1-8 and 11-17 under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 4,364,144 to Moss et al. in view of U.S. Patent No. 5,953,784 to Suzuki et al. In taking this position, the Examiner described in detail on page 2 of the Office Action the features allegedly taught by Moss et al. Those features include a cleaner body comprising an insertion portion into which a supporting body for supporting the cleaner may be inserted, the supporting body being a handle with supporting rods as well as a grip, a fringe belt composed of a large number of fringes on a side in a longitudinal direction and a fringe supporting section for supporting each of the fringes, with the fringe belt being made of a non-woven fabric.

The Examiner has acknowledged that Moss et al. fail to teach the fringe belts being fusion bonded to the surface of the cleaner, use of a plurality of fringe belts partially overlapping with one another, a water absorbing fiber bound body obtained by bundling a large number of fibers and being fusion bonded to the surface of the cleaner, the fringe belt being fusion-bonded

to the periphery of the fiber bound body, and the fringe belt being convexly curved in a direction of inserting the supporting body.

Regarding this lengthy list of deficiencies in the teachings of Moss et al., the Examiner has taken the position that Suzuki et al. teach “fusion-bonding fabric materials to the insertion of a cleaning body, and the cleaning body having a large number of fibers fusion-bonded to the surface of the cleaner.” The Examiner has alleged that it would be obvious to one of ordinary skill in the art at the time the invention was made to provide these alleged details of Suzuki et al. to the Moss et al. device.

Without reliance upon a cited prior art reference, the Examiner finally stated the following:

“It would have been further obvious to provide the tool of Moss with the fringe belt being fuse-bonded [sic] to the periphery of the fiber bound body, the fringe belt being convexly curved in a direction of inserting the supporting body ...”.

Regarding these features, the Examiner indicated that they would be obvious matters of design choice.

The Examiner has cited column 13, lines 28-38 of Suzuki et al., presumably for the teaching of “fusion-bonding.” In this regard, with reference to that section of Suzuki et al., the following is noted: “The wire-like fibrous material composing the dusting portion 33' is jointed to the sheet-like fibrous material 310' composing the cleaning portion 32' by sewing or heat sealing ...”. This disclosure is with reference to Figures 30a and 30b or Figures 31a through 31d. Review of these Figures fails to reveal any teaching or suggestion of a fiber bound body fusion

bonded to the surface of the cleaner body and at least partially surrounded by a fringe element or any analogous structure.

The Patent and Trademark Office has the initial burden of producing a factual basis for a rejection under 35 U.S.C. § 103. In other words, the Patent and Trademark Office must establish a prima-facie case for obviousness. If examination does not produce a prima-facie case of unpatentability under § 103, then without more, the applicant is entitled to a grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992). The issue of the prima-facie case for obviousness was visited by the Federal Circuit in *In re Thrift*, 63 USPQ 2002. In that case, the Federal Circuit stated the following:

“To establish a prima-facie case of obviousness the Board must, *inter alia*, show ‘some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’ *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). ‘The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.’ *In re Kotzab*, 217 F.3d 1365, 1370, 15 USPQ 2d 1313, 1317 (Fed. Cir. 2000).”

63 USPQ 2d at 2006. Put another way, the Federal Circuit ruled that a *prima facie* case of obviousness must establish: (1) some suggestion or motivation to modify the references; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ 2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. See *Ex parte Clapp*,

277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 974.

In *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), the U.S. Supreme Court announced the test that has since become the standard guideline for assessing patentability under 35 U.S.C. § 103. Under that section of the Patent Statutes, the Supreme Court stated that the inquiry was as follows:

“The scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.”

383 US at 17.

The Federal Circuit has also set forth several tenets of patent law concerning obviousness considerations:

“Our comments on the ... obviousness determination generally include the following tenets of patent law that must be adhered to when applying §103: (1) the claimed invention must be considered as a whole (35 U.S.C. 103: *see, e.g., Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984) (though the difference between claimed invention and prior art may seem slight, it may also have been the key to advancement of the art); (2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (*see, e.g., Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ

481, 488 (Fed. Cir. 1984); (3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983); ... “*Hodosh v. Block Drug Co., Inc.*, 229 USPQ 182 (CAFC 1986). Footnote 5 on page 187.

The inquiry as to when the issue of obviousness is to be resolved is that the inquiry is conducted “at the time the invention was made.” 35 U.S.C. § 103. In attempting to reject claims under 35 U.S.C. § 103, there must be a reason or suggestion in the art for making the combination of features suggested by the Examiner other than knowledge learned from applicant’s own disclosure. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1532 (Fed. Cir. 1988). The test to be applied is whether the references taken as a whole would suggest the invention to one of ordinary skill in the art. *Medtronic Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1582, 220 USPQ 97, 110 (Fed. Cir. 1983). Inherent in the forbiddance of the use of hindsight is the forbiddance of picking and choosing various features of different prior art references as a mosaic to recreate a facsimile of the claimed invention without a suggestion to combine them together in the references taken as a whole. *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1481, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986). Where the Examiner has picked and chosen various features from separate prior art references and has combined them together using applicant’s own disclosure as the blueprint to do so, such a rejection is fatally flawed and must be reversed. *Heidelberger Druckmaschinenag v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1072, 30 USPQ 2d 1377, 1379-80 (Fed. Cir. 1994); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). It is improper to use the inventor’s patent application as

an instruction book on how to reconstruct the prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1574, 1 USPQ 2d 1593, 1602 fn29 (Fed. Cir. 1987).

Independent Claim 1 requires the combination of at least one fringe belt fusion bonded to a surface of the cleaner body at the fringe supporting section and a fiber bound body fusion bonded to the surface of the cleaner body and at least partially surrounded at a periphery thereof by the fringe belt. This combination is nowhere taught or suggested by the combination of Moss et al. and Suzuki et al. The Examiner, in the outstanding Office Action, has conceded that this combination was not found during a diligent search of the prior art. Thus, the question must be asked as to where the Examiner has gone for the suggestion to combine Moss et al. and Suzuki et al. to meet the terms of independent Claim 1 (which generally corresponds to the combination of Claims 1, 5 and 6 as previously presented and rejected by the Examiner). The only possible answer is that the Examiner reviewed Applicant's disclosure and used that disclosure as a blueprint to assemble together a variety of features picked and chosen from the prior art. Such a procedure is forbidden in Patent Law. *Heidelberger Druckmaschinenag.*

Taking it a step further, in propounding this ground of rejection, it appears that the Examiner has improperly utilized Applicant's patent application as an instruction book on how to reconstruct the prior art. Such a procedure is improper. *Panduit Corp.* There is no teaching or suggestion in the prior art of record to fusion bond a fringe belt and a fiber bound body to the surface of a cleaner with the fringe belt at least partially surrounding the fiber bound body. As such, it is respectfully submitted that independent Claim 1 patentably distinguishes from the combination of Moss et al. and Suzuki et al. Claims 3, 4, 7, 9 and 12, dependent from Claim 1, are allowable for the same reasons.

Independent Claim 13 is similar to independent Claim 1, but is further limited by requiring the fringe to be fusion bonded to at least one surface of the hollow fabric body “in a convex arc following the shape of the hollow fabric body.” This is slightly different from the limitation in Claim 1 concerning the convex curvature of the belt but, more importantly, Claim 13 includes the combination of elements of a fringe fusion bonded to one surface of the hollow fabric body and at least partially surrounding a fiber bundle similarly bonded to the surface of the same body. Claim 13 includes the further proviso of a handle comprising the supporting body. Thus, for the same reasons set forth above with regard to independent Claim 1, independent Claim 13 is allowable.

Claims 16 and 18 depend from Claim 13 and are allowable for the same reasons.

New independent Claim 19 includes the combination of originally presented Claims 1 and 9, a combination that was indicated as allowable by the Examiner in the outstanding Office Action. As such, it is respectfully submitted that Claim 19 is patentable. Claims 20-26 all depend from Claim 19 and, as such, are allowable for the same reason.

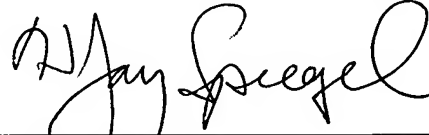
Accordingly, by this Amendment, it is respectfully submitted that all of the claims have been demonstrated to patentably distinguish from the prior art cited thereagainst in the outstanding Office Action. As such, reconsideration and allowance of this application are respectfully solicited.

If, for any reason, the Examiner believes that an interview with Applicant’s Attorney would be helpful in expediting the prosecution of this patent application, the Examiner is respectfully requested to telephone Applicant’s Attorney locally at (703) 619-0101 so that a discussion of any outstanding issues may be had.

Again, reconsideration and allowance of this application are respectfully solicited.

Respectfully submitted,

H. JAY SPIEGEL & ASSOCIATES

A handwritten signature in black ink, appearing to read "H. Jay Spiegel", written over a horizontal line.

H. Jay Spiegel
Attorney for Applicant
Registration No. 30,722

H. JAY SPIEGEL & ASSOCIATES
P.O. Box 11
Mount Vernon, Virginia 22121
(703) 619-0101 - Phone
(703) 619-0110- Facsimile
jayspiegel@aol.com - e-mail